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SEP 21 2007

OFFICE OF PETITIONS

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|---------------------------------|---|----------------------|
| In re Application of | : | |
| Dennis S. Janovici et al. | : | |
| Application No. 10/791,372 | : | DECISION ON PETITION |
| Filed: March 1, 2004 | : | PURSUANT TO |
| Attorney Docket No. 1131-102.US | : | 37 C.F.R. § 1.181(A) |
| Title: CLAMP CONNECTION AND | : | |
| RELEASE DEVICE | : | |

BACKGROUND

This is a decision on the petition pursuant to 37 C.F.R. § 1.181(a), filed May 21, 2007, to withdraw the holding of abandonment.

The above-identified application became abandoned for failure to fully reply in a timely manner to the Notice of Missing Parts (first notice), mailed July 2, 2004, which set a shortened statutory period for reply of two months. A response was received on October 8, 2004, along with a one-month extension of time. On October 21, 2004, the Office mailed a Notice of Incomplete Reply (Nonprovisional) (second notice), setting forth that Applicant's response was deficient in the amount of \$18, as he failed to submit the complete amount that was due for the additional claim fees. A response was received on October 28, 2004, but Applicant failed to include the required \$18. No additional extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested, and no further responses were received. Accordingly, the above-identified application became abandoned on January 9, 2005. A notice of abandonment was mailed on May 3, 2007.

RELEVANT PORTIONS OF THE C.F.R.37 C.F.R. § 1.16(i): National application filing, search, and examination fees.

In addition to the basic filing fee in an application, other than a provisional application, **for filing** or later presentation at any other time of each claim (whether dependent or independent) in excess of 20 (note that § 1.75(c) indicates how multiple dependent claims are considered for fee calculation purposes):

| | |
|-------------------------------|---------|
| By a small entity (§ 1.27(a)) | \$25.00 |
| By other than a small entity | \$50.00 |

(Emphasis added).

(It is noted that at the time that this notice was mailed, the fees were \$9 and \$18, respectively).

37 C.F.R. § 1.134: Time period for reply to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135: Abandonment for failure to reply within time period.

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

ANALYSIS

The showing in the present petition is not sufficient to withdraw the holding of abandonment because it is incomplete.

Decision on Petition pursuant to 37 C.F.R. § 1.181(a)

Petitioner has asserted that a response was submitted on October 4, 2004, and has included a copy of the same.

This response has been located in the electronic file, and it is noted that this is the above-mentioned incomplete response that was received in the Office on October 8, 2004. The response has been reviewed, and it is clear that Petitioner was aware that the response was deficient, however it is equally clear that he did not believe that the additional claim fees were due: the response of October 28, 2004 sets forth, *in pertinent part*:

Please cancel claims 8 and 9 without prejudice. With the cancellation of these claims, no further fees are required.

The present application went abandoned not due to the non-receipt of a response, but rather due to the fact that Petitioner failed to submit the required \$18.

The language of Rule § 1.16(i), reproduced above, makes it clear that a fee is assessed for the filing, and not the examination, of each claim in excess of 20. As such, the cancellation of a claim subsequent to the filing of the same does not obviate an Applicant's obligation to pay for an excess claim that was filed.

It follows that the present petition must be **DISMISSED**.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181(a)." This is not a final agency action within the meaning of 5 U.S.C § 704. The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail¹, hand-delivery², or facsimile³. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁴.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

2 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

3 (571) 273-8300- please note this is a central facsimile number.

4 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Decision on Petition pursuant to 37 C.F.R. § 1.181(a)

appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§ 1.137(a) and/or (b). Petitioner may download information about these petitions here:

http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c

No assurance can be made that any remedy will be forthcoming.

Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225⁵. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

⁵ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.